

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

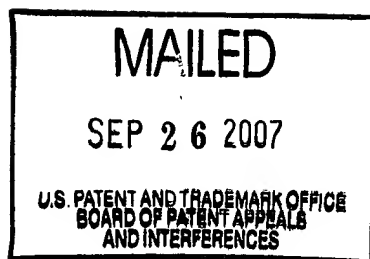
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Ex parte HONGJIE CAO, GARY T. MARTINO  
and  
PAUL H. RICHARDSON

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Application 09/932,435

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received electronically at the Board of Patent Appeals and Interferences on September 19, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matter requiring attention prior to docketing is identified below:

On May 24, 2007, an Order Returning Undocketed Appeal to Examiner was mailed which ordered that the Examiner's Answer mailed

December 13, 2006 be vacated and a revised Examiner's Answer be issued which includes the approval of the Technology Center Director or his/her designee due to the fact that the Examiner's Answer contains a new ground of rejection. On June 8, 2007, a compliant Examiner's Answer was mailed.

Section 1207.03 of the Manual of Patent Examining Procedure (MPEP)(Eighth Edition, Rev. 3, August 2005) states, in part:

In response to an examiner's answer which contains a new Ground of rejection, appellant must either file:

(A) a reply in compliance with 37 CFR 1.111 to request that the prosecution be reopened; or

(B) a reply brief that addresses each new ground of rejection in connection with 37 CR 41.37(c)(1)(vii) to maintain the appeal.

Since no response to the June 8, 2007 Examiner's Answer had been made of record, Pamela Bennett, Paralegal Specialist with the Board of Patent Appeals and Interferences, contacted attorney David LeCroy, Registration No. 37,869, on September 24, 2007, to see if a response had been filed. Mr. LeCroy stated that a response had not been filed.

Section 1207.03 further states:

(C) Failure to Reply to a New Ground of Rejection

If appellant fails to timely file a reply under 37 CFR 1.111 or a reply brief in response to an

examiner's answer that contains a new ground of rejection, the appeal will be *sua sponte* dismissed as to the claims subject to the new ground of rejection. . . .

If only some of the claims under appeal are subject to the new ground of rejection, the dismissal of the appeal as to those claims operates as an authorization to cancel those claims and the appeal continues as to the remaining claims. The examiner must:

(1) Cancel the claims subject to the new ground of rejection; and

(2) Notify the appellant that the appeal as to the claims subject to the new ground of rejection is dismissed and those claims are canceled.

Examiner may use form paragraph 12.179.02 to dismiss the claims subject to the new ground of rejection.

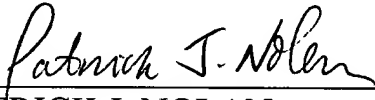
Accordingly, it is

ORDERED that the application is returned to the Examiner:

1) to cancel the claims subject to the new ground of rejection and  
notify appellants that the appeal as to those claims is dismissed; and

2) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

By:   
PATRICK J. NOLAN  
Deputy Chief Appeals Administrator  
(571) 272-9797

PJN:psb

National Starch and Chemical Company  
P.O. Box 6500  
Bridgewater, NJ 08807-3300